

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Ex parte JOYCE BRETT

Appeal No. 2006-0160
Application No. 10/029,818

ON BRIEF

Before FRANKFORT, CRAWFORD and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of the sole claim
pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a method of displaying jewelry, such as rhinestone jewelry, on a person at a location on which a cosmetic is typically applied on said person, the method including using an adhesive bandage, applying an adhesive deposit in a viscous state on the surface of the gauze pad portion of the bandage opposite the side to be applied to the person's skin such that the adhesive flows within venting openings in the bandage, applying a rhinestone jewelry display onto the adhesive deposit, allowing the adhesive deposit to cure to permanently attach the jewelry display thereto and attaching the adhesive bandage, with attached rhinestone jewelry display on the person. A copy of the claim under appeal is set forth in the appendix to the appellant's brief.

Applied Prior Art

Arginsky	Des. 340,988	Nov. 2, 1993
Vesey	6,455,752	Sep. 24, 2002
Amen-Ra A	6,472,039	Oct. 29, 2002

The following rejections are before us for review.

The claim stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the art that appellant, at the time the application was filed, had possession of the claimed invention.

The claim also stands rejected under 35 U.S.C. § 103 as being unpatentable over Vesey in view of Arginsky and Amen-Ra A.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the examiner's answer (mailed April 27, 2004), first supplemental examiner's answer (mailed April 8, 2005) and second supplemental examiner's answer (mailed May 3, 2005) for the examiner's complete reasoning in support of the rejection and to the appellant's brief (filed February 25, 2004), first reply brief (filed May 11, 2004), second reply brief (filed April 22, 2005) and third reply brief (filed May 13, 2005) for the appellant's arguments thereagainst. The unusual number of reply briefs and supplemental answers in the record of this application subsequent to the brief and first reply brief is in large part the result of the inexplicable and seemingly unfounded statement on page 1 of appellant's first reply brief to the effect that the rejection under 35 U.S.C. § 112, first paragraph "is apparently withdrawn."

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claim, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations, which follow.

We turn our attention first to the rejection under 35 U.S.C. § 112, first paragraph. The basis of the examiner's rejection, as set forth on page 3 of the answer, is that "[f]irst and second adhesive deposits were never shown or disclosed." In light of appellant's explanation on page 3 of the brief that the present application discloses two adhesives, one (the one on extending adhesive strips 10, 22) deposited by the manufacturer of the adhesive bandage and the other (adhesive 34) by the appellant in preparation of arranging for a jewelry display using the bandage, the examiner clarified the rationale for the rejection as follows:

Appellant did not disclose that the adhesive was applied on the strips, nor could appellant have any control of that step, as that is done by the adhesive bandage manufacturer. The adhesive surface could be applied as the laterally extending strips are formed, or the laterally extending strips could have a basic adhesive property and not need adhesive to be applied [answer, page 7; first supplemental answer, page 3].

The examiner's position is not well founded. There is no requirement in 35 U.S.C. § 112 that each step recited in a method claim be controlled by appellant. We likewise find no prohibition therein against appellant including as part of a method claim

steps directed to the provision of disclosed properties of an article used in the method disclosed in appellant's specification. In this case, appellant's specification (e.g., page 2) was sufficiently clear in its disclosure that the strips of the adhesive bandage extending from the gauze pad are "adhesive strips" (i.e., strips having adhesive on one surface thereof) to convey to one of ordinary skill in the art that the laterally extending strips have adhesive deposit applied to at least one surface thereof. Inasmuch as the claim is not specific to the manner in which such adhesive deposit is applied thereto, the subject matter of the claim finds full support in appellant's application as filed. The rejection is not sustained.

We turn our attention next to the rejection of the claim as being unpatentable over Vesey in view of Arginsky and Amen-Ra A. While appellant's brief illustrates an inexplicable confusion with regard to the basis (i.e., obviousness) of the prior art rejection, appellant's brief (page 4) correctly recognizes the deficiency in the applied prior art of any teaching or suggestion to apply an adhesive deposit *when in a viscous state* on the display surface of the Vesey bandage, flowing said adhesive deposit into the venting openings of said display surface, as called for in appellant's claim.

Vesey discloses a kit containing components for making decorated adhesive bandages. The kit contains one or more adhesive bandages, of the type described by appellant, comprising a backing strip 2, a layer of adhesive 3 on the body-contacting surface thereof, an absorbent pad 4 and a pair of release tabs 5, 6. According to

Vesey (column 5, line 21), the backing of the bandage is preferable clear and, if made from a film or foam, is preferably perforated (column 3, lines 27-28). In light of Vesey's disclosure of perforations in the backing strip, the examiner's application of Arginsky for this feature would appear to be superfluous.

Vesey's kit further includes a plurality of decorative elements 11 which may be selected from adhesive stickers and adhesive tattoos. Adhesive stickers are typically supplied on a sheet of release paper 15, with each sticker comprising a substrate printed on one face and carrying an adhesive layer 13 on the other face thereof. Vesey discloses that the adhesive material for the decorative elements is a pressure sensitive adhesive and teaches, in the Example discussed in columns 5 and 6, applying the adhesive to the release strip, evaporating the volatiles from the adhesive emulsion in an oven and laminating a plasticized polyvinyl chloride film (the substrate) to the adhesive to form a release paper-adhesive laminate which is then printed on the face of the substrate opposite the adhesive with a decorative pattern which is then cured. Following curing, the sheet containing the decorative patterns is kiss-scored in registration with the pattern on the laminate. The adhesive stickers can then be removed from the release paper and secured to the display surface of the bandage.

Amen-Ra A discloses an appliqu  for application to a body part, such as a nail, the appliqu  comprising a thin flexible film having an array of decorative rhinestones adhesively secured on an upper surface thereof and having a self-adhesive layer on a

bottom surface thereof. Amen-Ra A teaches that the adhesive used for securement of the rhinestones or other materials on the upper surface of the appliqués “may be those adhesives known in the art which will not dissolve the polymeric substrate and which will act to secure the rhinestones or other materials to the upper surface of the substrate in a secure manner” (sentence bridging columns 4 and 5).

Arginsky, a design patent, simply discloses an adhesive bandage having decorative indicia thereon. Figure 1 of the patent appears to illustrate venting openings in the adhesive strip in the central region thereof where the gauze pad is typically located.

None of the cited references teaches or suggests applying an adhesive deposit, when in a viscous state, on the display surface of a bandage, flowing the adhesive deposit into the venting openings therein, as called for in appellant’s claim. It follows that the combined teachings of the applied references are insufficient to establish a *prima facie* case of obviousness of the subject matter of appellant’s claim. The rejection is not sustained.

CONCLUSION

To summarize, both of the examiner's rejections are REVERSED.

REVERSED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

~~MURRIEL E. CRAWFORD~~
Administrative Patent Judge

JENNIFER D. BAHR
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